

### REMARKS

This response is being filed with a Request for Continued Examination (RCE).

The applicant respectfully submits that each rejection raised has been appropriately resolved herein. Each rejection is addressed below, preceded by a heading similar to that found in the Office action.<sup>1</sup>

Claims 1-5, 8 and 25-38 are pending in this application. Claims 1-5, 8 and 25-37 have been rejected. In this response, Claims 1, 3-4, 25, 30, 33-36 have been amended. No new matter has been added.

Reconsideration and withdrawal of the rejections set forth in the Final Office Action dated February 25, 2010, are respectfully requested in view of the remarks below.

#### 35 U.S.C. § 112 Rejections

##### Claims 1-5, 8 and 25-37

The Examiner has rejected claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner has rejected claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner has rejected claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, first paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter.

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<sup>1</sup> Silence regarding the position taken, or argument made, by the Examiner does not indicate any acquiescence to that position or argument. Furthermore, arguments made by the applicants with respect to a particular claim or claims apply only to those claim or claims, and not to other claims or patents/applications, unless specifically noted herein.

Although applicant respectfully disagrees, independent claims 1, 25 and 33 have been amended such that the examiner's basis for the rejection is no longer applicable. The portion of the specification cited by the Examiner in the Final Office action explicitly and inherently supports the claimed subject matter as recited in claims 1, 25, and 33, as previously submitted and as amended.

Moreover, the specification as-filed, at least in the originally filed claims, explicitly supports the subject matter of claims 1, 25, and 33. For example, the original claim 3 as filed (Page 10 of specification) recites "wherein the tracked movements are used to control a display."

Regarding claims 5, 26, and 33, the specification as-filed, at least in the originally filed claims, explicitly supports the claimed subject matter (see, for example, at least claim 5 as-filed on Page 10 of the Specification).

Regarding claims 29, 32, and 36, specification as-filed explicitly supports the claimed subject matter (see, for example, at least Lines 9-22 on Page 9 of the Specification). The disclosure explicitly states that a chip "can be mounted" to minimize physical space of the device thus provides support for "selecting an angle to optimize the size/height of the device."

The withdrawal of the rejection of claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, first paragraph, is thus respectfully requested.

The Examiner has rejected claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter.

Although applicant respectfully disagrees, independent claims 1, 3, 4, 25 and 33 have been amended such that the examiner's basis for the rejection is no longer applicable.

Regarding claim 29, applicant disagrees with the Office action's position that the "specification does not provide a standard for ascertaining the requisite degree" for the term "optimize". In particular, in one instance, the specification in lines 21-22 of Page 9 provides an example defining the parameters of an optimized angle. The Examiner's rejection of claim 29 under 35 U.S.C. § 112, second paragraph, is thus improper.

The withdrawal of the rejection of claims 1-5, 8 and 25-37 under 35 U.S.C. § 112, second paragraph, is thus respectfully requested.

#### 35 U.S.C. § 103(a) Rejections

##### Claims 1-3, 5, 8, 25-28, 30, 31, 33, 34 and 37

The Examiner has rejected claims 1-3, 5, 8, 25-28, 30, 31, 33, 34 and 37 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Feinstein (U.S. Patent No. 6,466,198 B1, hereinafter "Feinstein") in view of Svancarek (U.S. Patent No. 6,249,274 B1). Applicant respectfully disagrees.

#### THE REFERENCES, ALONE OR IN COMBINATION, LACK CLAIMED ELEMENTS

KSR decision in no way relieves the Patent Office of its obligations to "consider all claim limitations when determining patentability of an invention over the prior art."<sup>3</sup> Accordingly, it remains well settled law that a finding of "obviousness requires a suggestion of *all limitations* in a claim." In the aftermath of KSR, the Board of Patent Appeals and Interferences has repeatedly reversed findings of obviousness when the Examiner has failed to proffer references containing all claim limitations. See, e.g., Wada, 2008 WL 142652 at \*5 which states "because the Examiner has not explained why *every limitation* in claim 89 would have been obvious to a person of ordinary skill

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<sup>3</sup> KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

in the art, we agree with Appellants that the Examiner has not made out a case of prima facie obviousness." (emphasis added); and see Ex Parte Challapali, 2008 WL 111346, \*4-6 (Bd.Pat.App. & Interf., Jan. 10, 2008), reversing finding of obviousness because the Examiner failed to establish sufficient reasoning for combining the references.

The device of claim 1, among other features, includes a motion sensor having, "an accelerometer chip mounted at a first non-zero angle to a first plane parallel to the circuit board such that the accelerometer chip is slanted with respect to the circuit board."

Feinstein and Svancarek, when viewed alone or in combination, do not teach the above-emphasized subject matter of claim 1.

The Final Office action acknowledges that Feinstein is deficient ("Feinstein does not appear to expressly disclose an accelerometer chip mounted at a zero angle to a first plane parallel to the circuit board such that the accelerometer chip is slanted with respect to the circuit board" Page 12 of Final Office action), and attempts to rely on Svancarek.

However, Svancarek does not cure the deficiency.

Svancarek teaches a computer input device with inclination sensors (Title, Svancarek). However, Svancarek also does not teach that a hand held device includes a motion sensor having an accelerometer chip that is "mounted at a first non-zero angle to a first plane parallel to the circuit board such that the accelerometer chip is slanted with respect to the circuit board", as recited in claim 1.

In support of the rejection, the Office action points to FIG. 4 and col. 5-7 of Svancarek. However, the cited sections merely describe the sensors as being mounted

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<sup>3</sup> CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003) (emphasis added) (cited in Ex Parte Wada, 2008 WL 142632, \*4 (Bd.Pat.App. & Interf., Jan. 14, 2008)).

such that the sensing axes are *offset relative to primary axis*, rather than the circuit board.

Svancarek actually makes no mention of the accelerometer's orientation with respect to a circuit board and thus does not teach or suggest the claimed subject matter of an accelerometer chip that is "mounted at a first non-zero angle to a first plane parallel to the circuit board such that the accelerometer chip is slanted with respect to the circuit board", as recited in claim 1.

Overall, none of the applied references, singly or in any motivated combination, disclose or suggest the features recited in independent claim 1, and thus claim 1 is allowable based on at least the above stated reasons. Independent claims 25 and 33 recite same/similar subject matter as claim 1 and are also allowable, based on at least the above stated reasons.

The withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested for independent claims 1, 25, and 33.

#### Dependent Claims

In dependent claim 2, the accelerometer chip is "further mounted at a second non-zero angle with respect to a second plane perpendicular to the circuit board." Since Svancarek is not concerned circuit board orientation nor is it concerned with accelerometer chip orientation relative to a circuit board, Svancarek also does not teach, disclose, or fairly suggest the claimed subject matter of claim 2. Claim 2 is thus also allowable over the cited references, based on at least the above stated reason.

Claims 3-5, 8, 26-32 and 34-38, which depend from independent claims 1, 25 and 33 are allowable at least for depending from an allowable base claim, and potentially for other reasons as well.

Since the dependent claims are allowable for the reasons provided above, a specific discussion of the prior art associated only with rejections of the dependent

claims is not necessary for the purpose of overcoming the rejections. Applicant's silence regarding the applicability of any particular reference should not be taken as agreement with, or acquiescence to, any particular rejection. Applicant respectfully requests that the Examiner re-evaluate of the rejections.

The withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 2-5, 8, 26-32 and 34-38 are respectfully requested.

#### No Disclaimers or Disavowals

Although this communication may include changes to the application or claims, or characterizations of claim scope or referenced art, the applicant is not conceding that previously pending claims are not patentable over the cited references; instead, any changes or characterizations are being made to facilitate expeditious prosecution of this application. Thus, the applicant reserves the right to later pursue any previously pending claims, or other broader or narrow claims, that capture any subject matter supported by this application, including subject matter that might be found disclaimed herein or by any earlier prosecution. Accordingly, anyone reviewing of this or any parent, child, or related prosecution history shall not reasonably infer that the applicant has disclaimed or disavowed any subject matter supported by this application.

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

If the Examiner believes a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned at (650) 838-4306 to arrange for such a conference.

Please charge any deficiencies or credit any overpayments to our Deposit Account No. 50-2207, under Order No. 59559-8017.US01 from which the undersigned is authorized to draw.

Dated:

Respectfully submitted,

8/25/2010

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